



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

WASHINGTON, DC 20231

www.uspto.gov

IT 33

FRANCIS A PAINTIN ESQ,
WOODCOCK WASBURN KURTZ
MACKIEWICZ & NORRIS
ONE LIBERTY PLACE-46TH FLOOR
PHILADELPHIA, PA 19103

Paper No: 33
Appeal No: 2003-1016
Appellant: PORTER JOHN ROBERT
Application: 09/450,999

MAILED

APR 04 2003

**Board of Patent Appeals and Interferences
Docketing Notice**

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Application 09/450,999 was received from the Technology Center at the Board on March 5, 2003 and has been assigned Appeal No: 2003-1016.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: July 1, 2002
Reply Brief filed on: October 18, 2002
Request for Hearing filed on: None

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231**

The facsimile number of the Board is 703-308-7952. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 703-308-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 34

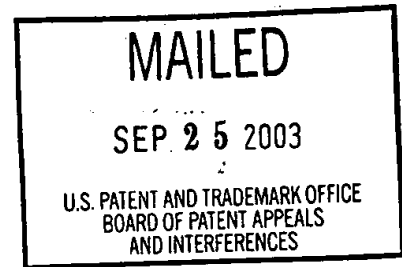
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN R. PORTER,
JOHN C. HEAD,
GRAHAM J. WARRELOW, and
SARAH C. ARCHIBALD

Appeal No. 2003-1016
Application No. 09/450,999

ON BRIEF



Before WINTERS, ADAMS, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 2 through 13, 15 through 17, and 19 through 22. Claim 14, which is the only other claim remaining in the application, stands allowed.

A correct copy of the appealed claims may be found in Appendix A attached to the Appeal Brief (Paper No. 29).

The Cited Reference

In rejecting applicants' claims on non-prior art grounds, the examiner cites the following reference:

Hawley, The Condensed Chemical Dictionary, p. 25 (Van Nostrand Reinhold Co., NY 1977)

The Rejection

Claims 2 through 13, 15 through 17, and 19 through 22 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief (Paper No. 29) and the Reply Brief (Paper No. 31); (3) the Examiner's Answer (Paper No. 30); and (4) the above-cited reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection.

Discussion

The examiner argues that claims 2 through 13, 15 through 17, and 19 through 22 are indefinite within the meaning of 35 U.S.C. § 112, second paragraph, in view of these terms recited in independent claim 16: "cycloaliphatic;" "polycycloaliphatic;" and "heteropolycycloaliphatic." We disagree.

In our judgment, this is not a close case and we shall not belabor the record with extended commentary. Essentially, we agree with the position set forth by applicants in their Appeal Brief and Reply Brief and we shall adopt that position as our own. We add the following comments for emphasis.

The examiner argues that "cycloaliphatic" is improper and indefinite and suggests that that term be replaced with "alicyclic." In support of this position, the examiner refers to the definition of "alicyclic" at page 25 of the 1977 edition of The Condensed Chemical Dictionary, published by Van Nostrand Reinhold Co. We note, however, that applicants' filing date postdates the dictionary relied on by the examiner by more than 20 years.

As established by evidence in Appendix B attached to Paper No. 29, the state of the art has advanced over the years, i.e., "cycloaliphatic" and "alicyclic" now appear to synonyms. To emphasize this point, we refer to the following definition of "cycloaliphatic" at page 288 of Merriam-Webster's Collegiate Dictionary, Tenth Ed., (Merriam-Webster, Inc. 1998)(copy enclosed with this opinion):

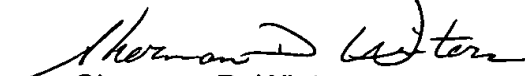

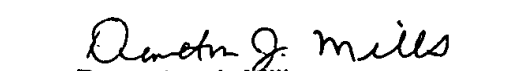
cycloaliphatic: alicyclic

Accordingly, we are persuaded that applicants' claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. In our judgment, the claims at issue are not indefinite in view of the recitation "cycloaliphatic."

The rejection under 35 U.S.C. § 112, second paragraph, is reversed.

One further matter warrants attention. On page 9 of the Examiner's Answer (Paper No. 30), we note a red box with red print and associated symbols. Such indicia appear highly irregular and unauthorized for use in official government correspondence. Nor is it clear what purpose such indicia serve. We think it advisable that the examiner consult with appropriate PTO officials before using such indicia in the future.¹

In conclusion, we reverse the examiner's rejection under 35 U.S.C. § 112, second paragraph. We also invite attention to the red box with red print and associated symbols appearing at page 9 of Paper No. 30 because such indicia appear highly irregular and unauthorized for use in official government correspondence.

)	
Sherman D. Winters)	
Administrative Patent Judge)	
)	
Donald E. Adams)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
Demetra J. Mills)	
Administrative Patent Judge)	

¹ On this record, the red box with red print and associated symbols first appeared at page 10 of the Final Rejection (Paper No. 25). Such indicia also appear in Paper Nos. 27 and 32.

Appeal No. 2003-1016
Application No. 09/450,999

Page 5

Francis A. Paintin, Esq.
Woodcock, Washburn, Kurtz,
Mackiewicz & Norris
One Liberty Place - 46th Floor
Philadelphia, PA 19103

dem